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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,593	01/16/2002	Charles A. King	N1375-002	4652

32905 7590 05/13/2003  
JONDLE & ASSOCIATES P.C.  
9085 EAST MINERAL CIRCLE  
SUITE 200  
CENTENNIAL, CO 80112

EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 05/13/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/050,593

Applicant(s)

KING ET AL.

Examiner

David A. Lambertson

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24, 27-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 27-35 and 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Receipt is acknowledged of a reply, filed February 24, 2003 as Paper No. 8, to the previous Office Action. Amendments were made to the claims; specifically, claims 25,26 and 36 were cancelled.

Claims 1-24, 27-35 and 37-40 are pending and under consideration in the instant application. Any rejection of record in the previous Office Action, Paper No. 4, mailed August 23, 2002, that is not addressed in this action has been withdrawn.

### ***Information Disclosure Statement***

The information disclosure statement filed February 21, 2003 as Paper No. 6 has been considered and a signed and initialed copy of the form PTO-1449 has been attached to this Office Action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 19-24, 27-29, 32-35 and 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Loh *et al.* (US Patent Application 2002/0058327 A1; see entire document). **This rejection is maintained for reasons set forth in the previous Office Action.**

***Response to Arguments Concerning Claim Rejections - 35 USC § 102***

Applicant's arguments filed February 24, 2003 have been fully considered but they are not persuasive. Specifically, Applicant raises the following issues with regard to the previous rejection of the claims under 35 USC 102(e): the teachings of Loh *et al.* discusses the induction of nolA and its effect on nodulation, whereas the present invention does not involve nolA.

This is not sufficient to overcome the instant rejection for the following reasons:

1. The standard by which a claim or claims can be rejected by prior art does not concern whether or not the teachings are identical to the teachings of the instant specification, but rather concerns whether or not the teachings of the prior art anticipates the subject matter that is claimed. Thus, simply stating that the applied art teaches something that is not taught by the instant specification is not sufficient to disqualify the art as anticipatory.
2. The teachings of Loh *et al.* does in fact anticipate the claimed invention because it teaches every limitation of the indicate claims. Specific reasons for the anticipatory nature of the claims are set forth in the previous Office Action. A very brief summary is presented here for clarification:

Loh, *et al.*, describes a method for enhancing nitrogen fixation in legumes using *Bradyrhizobium japonicum* strains having a competitive advantage over indigenous strains, (see abstract, page 2, paragraphs [0017-0019]) which are produced by genetically engineering them via the introduction of nucleic acid mutations or expression cassettes (page 4 paragraph [0045], [0048], page 7, paragraph [0071]) containing selectable markers which include herbicide resistance genes (see page 5, paragraph [0056], page 6-7, paragraph [0069]). Loh, *et al.*, further

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describes that the strains may be applied to the roots of plants (page 5-6, paragraph [0058]), and that these plants include any leguminous plant, including soybean (page 3, paragraph [0038], page 4, paragraph [0048]). Furthermore, Loh, *et al.*, teaches both the resulting genetically modified bacterial cells (page 4, paragraph [0045]) and the plants to which said bacterial cells have been applied (page 5, paragraph [0057]).

In conclusion, these teachings fall within the broad scope of the present claims, therefore the teachings anticipate the claims as recited. As a result, the rejection is maintained for the reasons set forth in the previous Office Action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loh *et al.* (US Patent Application 2002/0058327 A1) as applied under 35 USC 102(e) above, in view of Holmes *et al.* (US Patent No. 6,407,316; see entire document). **This rejection is maintained for reasons set forth in the previous Office Action.**

### ***Response to Arguments Concerning Claim Rejections - 35 USC § 103***

Applicant's arguments filed February 24, 2003 have been fully considered but they are not persuasive. Specifically, Applicant raises the following issues with regard to the previous

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rejection of the claims under 35 USC 103(a): 1. The teachings of Loh *et al.* discusses the induction of nola and its effect on nodulation, whereas the present invention does not involve nola; 2. The Examiner has not established a *prima facie* case because there is a lack of motivation with respect to combining the indicated teachings.

This is not sufficient to overcome the instant rejection for the following reasons:

1. As stated above under the “Response to Applicants Arguments Concerning Claim Rejections- 35 USC § 102,” the currently applied rejection meets the standards for an anticipatory prior art rejection by teaching all of the elements set forth in the claims.
2. The Examiner has indeed provided motivation for the combination of the references, specifically stating that one of ordinary skill in the art “would have been motivated to combine the teachings of Loh, *et al.*, with those of Holmes, *et al.*, in order to increase the range of herbicides which could act as useful selection markers when constructing herbicide resistant rhizobial strains” (see page 6 of the previous Office Action). Contrary to applicant’s assertion, the herbicide gene is considered to be a gene of interest because the selection process specifically selects for the presence of the gene. Furthermore, additional herbicide genes were well known in the art, and had been used for the same selection process set forth in Loh *et al.*, therefore it was obvious to make use of the additional herbicide resistant genes, as set forth in the previous Office Action. As such, the Examiner clearly set forth a *prima facie* case for obviousness in the previous Office Action.

In conclusion, the rejection is maintained for the reasons set forth in the previous Office Action because applicant has not provided a substantial reason as to why the rejection was improper.

*Allowable Subject Matter*

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucei, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson  
May 7, 2003

DAVID GUZO  
PRIMARY EXAMINER  
*David Guzo*